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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,617	03/08/2001	Sanaa F. Abdelhadi	AUS9-2000-0929-US1	8315

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EXAMINER	
CAMPBELL, JOSHUA D	
ART UNIT	**PAPER NUMBER**
2179	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/801,617	ABDELHADI ET AL.	
	Examiner	Art Unit	
	Joshua D Campbell	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment and Affidavits filed on 09/07/2004.

2. Claims 1-20 are pending in this case. Claims 1, 5, 9, 13, 15, 17, 18, 19, and 20 are independent claims.

Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131

3. The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP §715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131). The showing of facts must be sufficient to show conception of the invention prior to February 22, 2001, (the effective date of the reference) coupled with due diligence from prior to February 22, 2001, to March 8, 2001, (the filing date of the application) (constructive reduction to practice).

a. **Conception**

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). The statement in the applicants' declaration "The disclosure describes caching a portion of Web document which is hyperlinked to a current Web document at a receiving Web station so that the user has the option of previewing that linked Web document by popping up the cached portion," is insufficient because it fails to provide a clear explanation of the exhibit.

After thoroughly examining Exhibit A the examiner feels that the evidence of conception does in fact exist in the exhibit, regardless of the lack of a clear and concise explanation of those facts in the inventors declaration.

b. **Diligence**

The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field (February 22, 2001) of the party who was first to reduce to practice and continues until the first conceiver reduces to practice (March 8, 2001). Hull v. Davenport, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) ("lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts"). What serves as the entry date into the field of a first reducer is dependent upon what is being relied on by the first reducer, e.g., conception plus reasonable diligence to reduction to practice (Fritsch v. Lin, 21 USPQ2d 1731, 1734 (Bd. Pat. App. & Inter. 1991), Emery v. Ronden, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974)); an actual reduction to practice or a constructive reduction to practice by the filing of either a U.S. application (Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)) or reliance upon priority under 35 U.S.C. 119 of a foreign application (Justus v. Appenzeller, 177 USPQ 332, 339 (Bd. Pat. Inter. 1971) (chain of priorities under 35 U.S.C. 119 and 120, priority under 35 U.S.C. 119 denied for failure to supply certified copy of the foreign application during pendency of the application filed within the twelfth month)).

The evidence submitted, in both the attorney's declaration and the applicants' declaration, is insufficient to establish diligence from a date prior to the date of reduction to practice of the Weiss et al. (US Patent Application Publication Number 2003/0014415, filed on February 22, 2001) reference to either a constructive reduction to practice or an actual reduction to practice. Both the applicants' and attorney's declarations and evidence fail to show diligence during the critical period (just prior to February 22, 2001 through March 8, 2001), instead the attorney's declaration shows evidence that predates the critical period but no evidence during the critical period, while the applicants' declaration shows no evidence at all dealing with diligence.

For the above reasons the Affidavit/Declaration Under 37 CFR 1.131 is not proper in its current form and thus not sufficient to prove conception or diligence in order overcome the previous rejections.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-13, 15, and 17-20 remain rejected under 35 U.S.C. 102(e) as being anticipated by Weiss et al. (hereinafter Weiss, US Patent Application Publication Number 2003/0014415, filed on February 22, 2001).

Regarding independent claim 1, Weiss discloses a method in which a user may use a web browser to select to view only a portion of a hypertext document that is linked to a hyperlink in any received hypertext document (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method in which the portion is accessed and stored by a display station (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method which enables the user to select and display the portion of the linked document (Page 2, paragraphs 0024-0043 of Weiss).

Regarding dependent claim 2, Weiss discloses a method in which a user may select to view the full document after viewing a portion of that document (Page 4, paragraphs 0092-0094 of Weiss).

Regarding dependent claim 3, Weiss discloses a method in which a user may select the size of the portion of the linked document to be viewed (Page 4, paragraphs 0081-0086 of Weiss).

Regarding dependent claim 4, Weiss discloses a method in which a user may use a web browser to select to view only a portion of a hypertext document that is linked to a hyperlink in any received hypertext document (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method in which the portion is accessed and stored by a display station (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a

method which enables the user to select and display the portion of the linked document (Page 2, paragraphs 0024-0043 of Weiss).

Regarding independent claim 5 and dependent claims 6-8, the claims incorporate substantially similar subject matter as claims 1-4. Thus, the claims are rejected along the same rationale as claims 1-4.

Regarding independent claim 9 and dependent claims 10-12, the claims incorporate substantially similar subject matter as claims 1-4. Thus, the claims are rejected along the same rationale as claims 1-4.

Regarding independent claim 13, Weiss discloses a method in which a user at a display station can select to view only a portion of a web page and based on that selection the portion of the web page is accessed from the web and displayed (Page 2, paragraphs 0024-0043 and Page 9, paragraphs 0190-0195 of Weiss).

Regarding independent claim 15, the claim incorporates substantially similar subject matter as claim 13. Thus, the claim is rejected along the same rationale as claim 13.

Regarding independent claim 17, Weiss discloses a method in which a user at a display station can select to view only a portion of a web page and based on that selection the portion of the web page is accessed from the web and displayed (Page 2, paragraphs 0024-0043 and Page 9, paragraphs 0190-0195 of Weiss).

Regarding independent claim 18, the claim incorporates substantially similar subject matter as claim 17. Thus, the claim is rejected along the same rationale as claim 17.

Regarding independent claim 19, Weiss discloses a method in which a user may use a web browser to select to view only a portion of a hypertext document that is linked to a hyperlink in any received hypertext document (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method in which the portion is accessed and stored by a display station (Page 2, paragraphs 0024-0043 of Weiss). Weiss also discloses a method which enables the user to select and display the portion of the linked document (Page 2, paragraphs 0024-0043 of Weiss).

Regarding independent claim 20, the claim incorporates substantially similar subject matter as claim 19. Thus, the claim is rejected along the same rationale as claim 19.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 14 and 16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. (hereinafter Weiss, US Patent Application Publication Number 2003/0014415, filed on February 22, 2001) as applied to claims 13 and 15 above, and further in view of Tracy et al. (hereinafter Tracy, US Patent Number 6,199,753, filed on November 4, 1999).

Regarding dependent claim 14, Weiss does not disclose a method in which a selected portion includes an incomplete image and that portion is accessed and displayed in text only mode. However, Tracy discloses a method in which a web page is displayed in text only format if there is not enough view space to properly display the images of the page in their entirety (column 11, lines 12-50 of Tracy). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Weiss with the method of Tracy because it would have allowed more of the textual content to be displayed on a smaller area.

Regarding independent claim 16, the claim incorporates substantially similar subject matter as claim 14. Thus, the claim is rejected along the same rationale as claim 14.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC
November 1, 2004

STEPHEN S. HONG
PRIMARY EXAMINER